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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/500,332	07/21/2004	Renato Ancorotti	3687-70	8959
23117 7590 09/24/2007 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203			EXAMINER AHMED, HASAN SYED	
			ART UNIT 1615	PAPER NUMBER
			MAIL DATE 09/24/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/500,332

Applicant(s)

ANCOROTTI, RENATO

Examiner

Hasan S. Ahmed

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1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of applicant's request for continued examination, which was filed on 6 July 2007.

\* \* \* \* \*

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6 July 2007 has been entered.

\* \* \* \* \*

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 20 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, dependent claims 20 and 31 recite water as the solvent of independent claims 18 and 29, respectively. However the Markush groups of claims 18 and 29 restrict the solvent to only those agents listed; water is not listed. Thus, claims 20 and 31 are inconsistent with claims 18 and 29. Clarification is required.

\*

2. Claims 20, 21, 29 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the claims are indefinite due to improper form of the Markush claim language. Markush claims are, for example, in the following form: "a compound selected from the group consisting of A, B and C." Since the applicants do not use proper Markush form, it is not known whether applicants intend to use multiple agents or a single agent.

\*

3. Claims 18 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, claims 18(d) and 29(d) recite the limitation, "if required." This limitation renders the claim indefinite as it is unclear when, if ever, the further sizing step would be required.

\*

4. Claims 22 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the claims recite the limitation "and/or." This limitation renders the claims indefinite as it is unclear whether both synthetic and natural pigments are required, or just one. Clarification is requested.

\* \* \* \* \*

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 18-39 are rejected under 35 U.S.C. 102(b) as being anticipated by Verdon, et. al. (U.S. Patent No. 4,994,264).

Verdon, et. al. disclose a process of making a press molded cosmetic composition (see col. 1, line 67 – col. 2, line 2).

The disclosed process is the instant process as claimed:

- the fatty emulsion (solvent and fats) of instant claims 18(a') and 29(a') (see Example, col. 4, line 65 – col. 5, line 23; Example, col. 4, line 65 – col. 5, line 23);
- the coloring powders of instant claims 18(a'') and 29(a'') (see col. 3, lines 54-58);
- the mixing of instant claims 18(b) and 29(b) (see Example, col. 4, line 65 – col. 5, line 23);

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- the extruding of instant claims 18(c) and 29(c) (see Example, col. 4, line 65 – col. 5, line 23);
- the drying of instant claims 18(d) and 29(d) (see col. 4, lines 32-36);
- the sizing of instant claims 18(e) and 29(e) (see col. 4, lines 11-13);
- the stearate of instant claims 19 and 30 (see Example, col. 4, line 65 – col. 5, line 23);
- the water of instant claims 20 and 31 (see col. 2, lines 41-44);
- the preserving agents of instant claims 21 and 32 (see col. 3, lines 63-66);
- the coloring powders comprising synthetic and/or natural pigments of instant claims 22 and 33 (see col. 3, lines 54-58);
- the ratio of phases of instant claims 23 and 34 (see col. 6, line 20);
- the extruder of instant claims 24 and 35 (see col. 4, line 28);
- the drying temperature and humidity of instant claims 26 and 37 (see col. 4, lines 34-36);
- the cosmetic of instant claims 27 and 38 (see Example, col. 4, line 65 – col. 5, line 23); and
- the blusher or eye shadow of instant claims 28 and 39 (see col. 1, line 17).

Although the Verdon reference does not explicitly recite the oven of instant claims 25 or 36, it recites drying at temperatures of about 40-55 degrees Celsius. It is inherent that the molded composition would only be dried at such high temperatures in an oven.

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2. Claims 18 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Hempel et al. (U.S. Patent No. 4,332,763).

Hempel, et. al. disclose a process of making a non-pressed powder cosmetic composition (see col. 1, line 57).

The disclosed process is the instant process as claimed:

- the fatty emulsion (fatty substances) of instant claims 18(a') and 29(a') (see col. 2, line 9);
- the coloring powders (dyes) of instant claims 18(a'') and 29(a'') (see col. 2, line 10);
- the mixing (kneading) of instant claims 18(b) and 29(b) (see col. 2, line 55);
- the extruding of instant claims 18(c) and 29(c) (see col. 2, line 60);
- the drying of instant claims 18(d) and 29(d) (see col. 2, lines 61-62); and
- the sizing of instant claims 18(e) and 29(e) (see col. 4, lines 62-66).

\* \* \* \* \*

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422

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F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-39 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-10 of copending Application No. 10/558,633 ('633). Although the conflicting claims are not identical, they are not patentably distinct from each other because '633 claims a process for the preparation of a cosmetic product comprising a coloring powders phase and an emulsion of fats phase. See claim 7.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

\* \* \* \* \*

### ***Response to Arguments***

Applicant's arguments filed on 6 July 2007 have been fully considered but they are not persuasive.

1. Applicants argue that, "...in Verdon the fatty components are indeed present in a phase separate from the slurry whereas in the present application the fatty components are in the slurry and the powdery, coloring components are in the coloring powders phase." See remarks, page 6.



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The term "phase" is defined as, "a homogenous, physically distinct, and mechanically separable portion of matter present in a nonhomogeneous physicochemical system." See Merriam-Webster Online Dictionary entry, attached. Applicants do not provide a special definition of the term "phase" in the instant specification.

Given the art accepted definition of the term "phase," the fatty phase components, i.e. octylpalmitate and polyglyceryl 3-diisostearate, and the coloring components of the Verdon reference read on the instant application as claimed. In Verdon, as instantly claimed, the fatty emulsion phase and the coloring phase are present in two distinct phases before they are mixed. Thus, examiner respectfully submits that the Verdon reference anticipates the instant application as claimed.

\*

2. Applicants argue that addition of the limitation "non-pressed powder" distinguishes the instant claims from the prior art. See remarks, page 7.

Examiner respectfully submits that the recitation "non-pressed powder" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

☆


**Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hasan S. Ahmed whose telephone number is 571-272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HUMERA N. SHEIKH  
PRIMARY EXAMINER